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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/316,546 | 05/21/1999 | JAY S. WALKER | WD2-99-012 | 7943 |

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EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/316,546

Applicant(s)

WALKER ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,8,9,10. 6) ☐ Other: _____

DETAILED ACTION

1. This application has been reviewed. Original claims 1-58 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4, 6-7, 21-24, 28-31, 40-43, 44, 51, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (6,119,099). In reference to independent claims 1, 44, 51, 56, and claims 2, 3, 6 and 7, Walker et al. discloses an interaction between a customer and a merchant at a point of sale (POS) terminal. The POS terminal “generates a purchase price of a purchase, and sets the required payment amount to be equal to the purchase price” (column 6, lines 5-7). The POS terminal then identifies an upsell and a rounded price for the upsell (column 6, lines 38-40) that the customer must pay in order to receive the benefit. The upsell offer is

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identified using “text and/or graphics that explain to the customer and/or cashier that the identified upsell may be purchased for the round-up amount” (column 6, lines 41-44). “The customer indicates to the cashier whether he accepts or rejects the offered upsell” (column 6, lines 45-46). Therefore the customer need not receive the coins from the original purchase and instead benefits by receiving an upsell (column 2, lines 43-45).

Claims 4, 28 and 29 are rejected; one embodiment disclosed states “upon accepting an upsell, either the cashier presents a pre-printed coupon to the customer, or the POS terminal prints one for the customer” (column 10, lines 10-12), thus providing a future discount.

Claims 21, 22, 23, 24 are rejected by Walker et al.; various embodiments are described to depict methods for determining the upsell. They can be based on the product being purchased such as a video store providing a movie rental upsell (column 5, lines 60-61), vouchers which attract customers to designated businesses (column 9, lines 62-64), supplemental products such as in grocery stores (column 5, lines 64-65) or just based on the price of the purchase and the change due to a customer (column 2, lines 10-11).

Claims 30 and 31 are rejected; “the POS terminal determines the upsell(s) by identifying at least one upsell in the database that corresponds to the compared upsell price” (column 7, lines 35-38) and the “customer indicates to the cashier whether he accepts or rejects the offered upsell” (column 7, lines 25-26).

Claims 40-43 are rejected; Walker et al. teaches after an offer is accepted, “the required payment amount is then set equal to the rounded price,” (column 2, lines 40-41) in order to reconcile and credit the merchant account. The customer’s financial account is debited “for the coins due to him” (column 2, lines 43-44) which is the required purchase amount. Once

accepted, Walker et al. teaches a selection button for a cashier to press based on the accepted offer from the customer, acting as a code at the point of sale terminal.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 8-10, 11-16, 34-39, 42, 49, 55, 33 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,199,099) in view of Fleischl et al. (6,038,552). Walker et al. teaches payment methods at point of sale terminals for receiving upsells, through cash payment. Walker fails to teach alternate methods of payment. Fleischl et al. teaches a payment method at point of sale terminal using both credit and debit transactions for purchases.

Referring to claims 8-10, Fleischl et al. describes purchasing through the use of a "credit card account having a credit limit" (column 2, line 55) based on items being purchased. Fleischl et al. teaches purchasing with a spending limit through the use of credit card and debit sales.

Claims 11-16 and 34-39 are rejected; Fleischl et al. mentions that the transaction processor calculates to determine whether the requested transaction amount would exceed the amount of the credit limit (column 4, lines 40-45). "The predetermined limit is preferably above zero..." (column 5, lines 12-13). Fleischl teaches the option and procedures for credit card purchase as well as debit card purchase, including having the necessary credit limit or debit balance required for purchases. It would be obvious to anyone of ordinary skill in the art, that in order to receive offers for such benefits, the account being charged would have to be in good standing and have an available credit limit or cash balance above zero after the original purchase as well as the supplemental purchase offered to the customer via the merchant terminal.

Claims 32, 49, 55 are rejected; Walker et al. also teaches the offer of payment being received in text or graphic format from the merchant (column 2, lines 34-36). Fleischl et al. requires a signature on a credit or debit receipt to prove authorization from the customer. It would be obvious to anyone of ordinary skill in the art, that ordinary credit card receipts could be used as the text offer by inserting an additional signature line when transmitting the supplemental purchase from the merchant to the customer. This would require the customer to sign the receipt, in the same manner that every day credit card receipts are signed.

Claims 33 and 50 are rejected, if the customer accepts the offer and an added purchase is received, the financial account would have to be adjusted again to reflect the purchase, similarly to the method in Fleischl et al. where after a purchase the transaction balance is updated (column

4, lines 51-53). The combination of Walker et al. and Fleischl et al. allow for a larger upsell technique through sales of not only cash, but also utilizing credit cards and debit cards.

8. Claims 5, 17-20 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,199,099) in view of Schulze (6,233,564). Walker et al. teaches upsell techniques, which require extra monetary value. Walker fails to mention other possible means for offering of an upsell such as filling out a survey.

Claims 5 and 45 are rejected, Schulze mentions that those that fill out surveys will receive "one or more consumer benefit receipts to each or at least some of those consumers that provide the supplemental or additional market data" (column 13, lines 55-58). Thus filling out the survey provides a benefit such as an upsell to the customer as taught by Walker et al. Referring to claim 17, the surveys are transmitted via the "survey network" so that the information can spread to future consumers.

Claims 20 and 48 are rejected, the survey is used to request information from the consumer based on product or services (column 6, lines 46-56) and is returned to the "survey network" when completed.

In reference to claims 18, 19, 46, and 47, the survey construction mentioned by Schulze addresses a wide variety of topics relating to the product. It would be obvious to anyone of ordinary skill in the art that questions relating to merchant quality and third party organizations are considered common when constructing a survey as well as the fact that questions for the survey should be gathered from multiple sources, such as the merchant and third party candidates.

9. Claims 25-27 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,199,099) in view of Boyer et al. (6,208,973). Walker et al. teaches upsells at point of sale terminals to acquire extra products from the extra change left over on sales but again fails to teach other means of acquiring the upsell. Other upsell techniques could call for the customer to join or commit to a service from a third party, if a discount is received on the original purchase.

Referring to claims 25-26 and 52-53, Boyer et al. teaches a payment system in which a "portion of the service to be paid by the third party payor and the portion to be paid by the customer" (column 3, lines 12-14), thus providing the customer with a discount. This requires the customer to utilize the service of the third party payor.

Claims 27 and 54; Boyer et al. describes an embodiment in which the third party payor provides a healthcare policy to the customer for utilizing the benefit. Boyer et al. mentions various embodiments such as third party services utilizing air miles or hotel reservations. It would be obvious to anyone of ordinary skill in the art that multiple services could be substituted for the customer to be required to participate in for utilizing the payment method. These services could include telephone service, Internet service, cable service and many others, all acting in a similar manner to the healthcare embodiment taught by Boyer et al.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Toader et al. US Patent 5,749,075 May 5, 1998. Method for providing prepaid Internet access and/or long distance calling including the distribution of specialized calling cards.

b) Walker et al. US Patent 5,945,653 August 31, 1999. System and method for establishing and executing functions to affect credit card accounts and transactions.

c) Maggard et al. US Patent 6,021,362 Feb 1, 2000. Method and apparatus for dispensing samples and premiums.

d) Deaton et al. US Patent 6,292,786 Sept. 18, 2001. Method and system for generating incentives based on substantially real-time product purchase information.

e) Peirce et al. US Patent 6,332,126 Dec. 18, 2001. System and method for a targeted payment system discount program.

f) Freeman et al. US Patent 6,450,407 Sept. 17, 2002. Chip card rebate system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

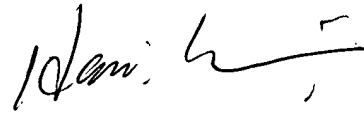
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

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Respectfully Submitted,
Stefano Karmis
September 24, 2002

A handwritten signature in black ink, appearing to read 'Hani M. Kazimi', with a stylized flourish at the end.

HANI M. KAZIMI
PRIMARY EXAMINER